

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Sukeyuki Shinotsuka et al.

Serial No.: 10/693,204

Filed: October 24, 2003

Atty. Dkt. No.: 7272-131/10312233

Group Art Unit: 2622

Examiner: Gevell V. Selby

Confirmation No. 2344

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**COMBINED PETITION FOR UNINTENTIONALLY DELAYED DOMESTIC AND
FOREIGN PRIORITY CLAIMS UNDER 37 C.F.R. §§ 1.78(a) AND 1.55(c)**

Applicants respectfully petition the Commissioner under 37 C.F.R. § 1.78(a)(3) and 37 C.F.R. § 1.55(c) for delayed claims of domestic and foreign priority, respectively.

Background

Applicants intended to file the current U.S. application as the national phase of international application PCT/JP02/003089 (“ the PCT application”). The PCT application was filed on March 28, 2002, designating the U.S. and claiming priority to four Japanese applications, namely:

JP 2001-170263, filed on April 27, 2001.
JP 2001-330010, filed on September 20, 2001;
JP 2001-385276, filed on November 13, 2001;
JP 2002-79681, filed on February 14, 2002.

However, the current application is considered by the Patent Office to be a regular U.S. application filed under 37 C.F.R. § 1.53(b). (*See* Decision, attached hereto).

Status of Current Application

The current application is waiting to be examined.

Discussion

The current application is considered to be a regular U.S. application and not the national phase of the PCT application. Therefore, Applicants are requesting that claims of domestic priority to the PCT application and foreign priority to the four Japanese applications be added in the current application, and that the current application be designated as a continuation of the PCT application in accordance with MPEP § 1895.01.

The current application was filed on October 24, 2003. The PCT application was filed on March 28, 2002, designating the United States, and published as WO 02/091736 A1 on November 14, 2002. The Japanese applications were filed between April 27, 2001 and February 14, 2002. PCT papers evidencing these circumstances were previously submitted in the current application. Because the requirements of 35 U.S.C. §§ 120 and 365(c) are satisfied with respect to the current application and the PCT application, a claim of domestic priority to the PCT application is proper. Also, the requirements of 35 U.S.C. § 119(a) are satisfied with respect to the PCT application and the Japanese applications, and therefore a claim of foreign priority to the Japanese applications is proper.

Relief Requested

Applicants respectfully request that the following claims of domestic and foreign priority be entered in the current application.

Applicants also request that a new Filing Receipt be issued to reflect the added claims of domestic priority and foreign priority.

Priority Claims

A. Domestic Priority

Applicants hereby claim priority under 37 C.F.R. § 1.78(a)(3) to PCT application PCT/JP02/003089, filed March 28, 2002.

A claim of domestic priority indicating that the current application is a continuation of the PCT application is submitted in the Application Data Sheet attached hereto (no previous Application Data Sheet was submitted).

Applicants state that the entire delay between the date the claim for priority was due under paragraph (a)(2)(ii) of 37 C.F.R. § 1.78 and the date this claim is filed was unintentional.

B. Foreign Priority

Applicants hereby claim priority under 35 U.S.C. § 119 to Japanese applications:

JP 2001-170263, filed on April 27, 2001.
JP 2001-330010, filed on September 20, 2001;
JP 2001-385276, filed on November 13, 2001;
JP 2002-79681, filed on February 14, 2002.

A claim of foreign priority to the Japanese applications is submitted in the attached Application Data Sheet.

Applicants state that the entire delay between the date the claim for priority was due under paragraph (a)(1) of 37 C.F.R. § 1.55 and the date this claim is filed was unintentional.

Certified copies of the Japanese applications are in the process of being obtained. The certified copies will be submitted as soon as they become available.

Applicants respectfully request that the delayed claims of domestic and foreign priority be entered in the current application, and that a new filing receipt reflecting both the domestic and foreign priority claims be issued.

Please charge \$ 1,370.00 for the unintentionally delayed domestic priority claim, and charge \$ 1,370.00 for the unintentionally delayed foreign priority claim.

No other fee is believed due. However, the Commissioner is hereby authorized to charge any fees that may be required with this paper or to credit any overpayment of fees to Deposit Account No. 50-0337.

Dated: June 4, 2007

Respectfully submitted,



Miles Yamanaka
Reg. No. 45,665

FULBRIGHT & JAWORSKI L.L.P
555 South Flower Street , 41st Floor
Los Angeles, CA 90071
(213) 892-9200 – Telephone
(213) 892-9494 – Facsimile

Attachments: Copy of Decision
Application Data Sheet



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ALEXANDRIA, VA 22313-1450
www.uspto.gov

FULBRIGHT & JAWORSKI
Twenty Ninth Floor
865 South Figueroa Street
Los Angeles, CA 90017-2576

In re Application of: SHINOTSUKA, et al.	:	
Application No.: 10/693,204	:	DECISION ON PETITION UNDER
Filing Date: October 24, 2003	:	37 CFR 1.182
Attorney Docket No.: 7272-131/10312233	:	
For: OUTPUT-COMPENSATING DEVICE	:	
AND METHOD OF AN IMAGE	:	
SENSOR	:	

This decision is issued in response to the "Petition Under 37 CFR 1.182 To Accept Substitute Translation Of PCT Claims" filed May 02, 2005. Applicant has paid the required petition fee.

BACKGROUND

On March 28, 2002, applicants filed international application PCT/JP02/03089, which claimed a priority date of April 27, 2001 and which designated the United States. The deadline for submission of the basic national fee and national stage entry was thirty months from the priority date, i.e., October 27, 2004.

On October 24, 2003, applicants initiated the present U.S. application by filing a transmittal letter and accompanying materials, including a specification and thirty-two claims. The transmittal letter used by applicant identifies the submission initially as an "Entry National Phase (PCT)" based on PCT/JP02/03089. However, the transmittal letter also identified the submission as a "Filing Under 37 CFR 1.53(b)."

On January 28, 2004, the USPTO mailed a "Notice To File Missing Parts Of Nonprovisional Application Filed Under 37 CFR 1.53(b)" indicating that the submission had been treated as a filing under 35 U.S.C. 111(a) and 37 CFR 1.53(b). The Notice required submission of an oath or declaration in compliance with 37 CFR 1.63 and the surcharge for late filing the oath or declaration.

On March 18, 2004, applicants filed a response to the Notice, including an executed declaration and the required surcharge payment.

On April 04, 2004, the USPTO issued a filing receipt.

On May 02, 2005, applicants filed the petition considered herein.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states the following:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

As noted above, applicant's October 24, 2003 filing included a transmittal letter that referred to the submission as both a national stage filing and a submission under 37 CFR 1.53(b). The inclusion of these two descriptions of the submission constitutes "conflicting instructions" which, pursuant to the MPEP, requires that the application be treated under 35 U.S.C. 111(a). Accordingly, the original papers deposited on October 24, 2003 were correctly treated as a filing under 35 U.S.C. 111(a).

The present petition is based on the mistaken belief that the present application is a national stage filing under 35 U.S.C. 371 and, therefore, that a translation of the claims contained in the international application is required. The petition is moot because, as discussed above, the present application is not a U.S. national stage of PCT/JP02/03089. Rather, it is a U.S. application filed under 35 U.S.C. 111(a). Accordingly, the claims filed October 24, 2003 are the claims of record herein, and the replacement of these claims with the claims from the international application would not be appropriate without an amendment under 37 CFR 1.121 directing the USPTO to amend claims 1-32.

It is noted that the filing receipt mailed herein on April 05, 2004 lists PCT/JP02/03089 under "foreign applications." This is inappropriate as PCT/JP02/03089 was filed more than one year prior to the filing date of the present application. Accordingly, a corrected filing receipt is issued herewith wherein the reference to PCT/JP02/03089 as a foreign application has been removed.

The present U.S. application does not at present include a claim of priority to any prior-filed applications. Applicant may be entitled, subject to 37 CFR 1.78(a)(2)(ii), to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No. 10/693,204) and the international application (PCT/JP02/03089) designating the United States were copending on October 24, 2003. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application by inserting a proper reference to the parent international application. An appropriate passage would be, "This is an continuation of

international application PCT/JP02/03089, filed 28 March 2002, which designated the United States and is now abandoned." Alternatively, applicant may submit an application data sheet with the benefit claim included therein. Applicant may need to file a petition and fee under 37 CFR 1.78(a)(3) to be entitled to make the claim.

Similarly, applicant may be entitled to claim the benefit of the Japanese priority applications identified in the international application. The addition of any such claims to the present application must be made pursuant to the requirements of 35 U.S.C. 119 and 37 CFR 1.55; a petition and fee under 37 CFR 1.55(c) may be required. In addition, applicant is reminded that in, order to perfect any claim for priority under 35 U.S.C. 119, applicant must submit a certified copy of the foreign priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.182 is **DISMISSED** as moot. The present application will continue to be treated as a filing under 35 U.S.C. 111(a) and 37 CFR 1.53(b). The claims of record are the claims filed with the original application papers on October 24, 2003.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182."

Please direct further correspondence with respect to this petition to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

The present application is being referred to the Technology Center Art Unit 2612.



Richard M. Ross
PCT Petitions Attorney
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459